



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/901,878

07/09/2001

Giovanni Seni

LX00071

5935

20280 7590 06/03/2004

MOTOROLA INC
600 NORTH US HIGHWAY 45
ROOM AS437
LIBERTYVILLE, IL 60048-5343

EXAMINER

CHANG, JON CARLTON

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 06/03/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,878

Applicant(s)

SENI ET AL.

Examiner

Jon Chang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2004 has been entered.

Response to Applicants' Amendment and Arguments

2. The amendment filed May 3, 2004, has been entered and made of record.

Applicants' arguments have been fully considered, but are not deemed to be persuasive for at least the following reasons. Applicants allege that neither Capps et al. nor Kuriyama et al., nor their combination teach "a circuit configured to provide a window for exclusively receiving and displaying handwritten data for text recognition." The Examiner disagrees. While Applicants do not provide any explanation, aside from making the allegation, the Examiner presumes, from previous arguments made by Applicants, their position is that the "gestures" taught by Capps et al. do not qualify as handwritten data for text recognition. It is the Examiner's position that Capps et al. still meets the language because all of the "gestures" in Capss et al. are performed by hand, using a stylus, and must be recognized by the system so that the appropriate operations can be performed in response.

Additionally, taking Applicants' interpretation of the claim, Applicants' own specification does not support the invention, as claimed. First, assuming that the input area 104 in Fig. 1, is the claimed "window", the specification further states, regarding Fig.2, "In this mode, the user interface displays a QWERTY keyboard 132 in the input area..." This language explicitly describes that the keyboard is displayed in the window. This means that in Fig.2, the window still exists, with a keyboard inside of it. The only other possible interpretation of Applicants' disclosure, is that the window is the area below the horizontal line which separates areas 102 and 104 (Fig.1). Even with this interpretation, Fig.2 still indicates that the window still exists, with a keyboard displayed in it. Since a keyboard is presented in the window, and utilized for input, the window is not "for exclusively receiving and displaying handwritten data for text recognition."

Second, page 11, at lines 13-15, the specification states, "In step 144, a check is made to determine when the handwritten entry is complete this is typically done with a timer, by pressing a space key or by a special pen gesture." Note, that neither "pressing a space key" nor a "pen gesture" would qualify as a "handwritten entry for text recognition" as Applicants would interpret it.

Claim Rejections - 35 USC § 112

3. Claims 54-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 54 recites, "a circuit configured to provide a window for exclusively receiving and displaying handwritten data for text recognition..." This is not supported in the original disclosure. First, assuming that the input area 104 in Fig. 1, is the claimed "window", the specification further states, regarding Fig.2, "In this mode, the user interface displays a QWERTY keyboard 132 in the input area..." This language explicitly describes that the keyboard is displayed in the window. This means that in Fig.2, the window still exists, with a keyboard inside of it. The only other possible interpretation of Applicants' disclosure, is that the window is the area below the horizontal line which separates areas 102 and 104 (Fig.1). Even with this interpretation, Fig.2 still indicates that the window has a keyboard displayed in it. Since a keyboard is presented in the window, and utilized for input, the window is not "for exclusively receiving and displaying handwritten data for text recognition."

Second, page 11, at lines 13-15, the specification states, "In step 144, a check is made to determine when the handwritten entry is complete this is typically done with a timer, by pressing a space key or by a special pen gesture." Taking Applicants' interpretation of "gesture" as evident in the prosecution history of this application, neither "pressing a space key" or a "pen gesture" would qualify as a "handwritten entry for text recognition."

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 54-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Capps and U.S. Patent 5,838,302 to Kuriyama et al. (hereinafter "Kuriyama").

As to claim 54, Capps discloses a hand-held electronic apparatus comprising:
a touch-enabled screen configured to receive and display information (Fig.2, element 52); and

a circuit (Fig.1) configured to provide an area for exclusively receiving and displaying handwritten data for text recognition (Fig.4a), to recognize single and multiple character words (Fig.4b) based on the handwritten data received and displayed in the area, and to restrict the area to a single location of the touch-enabled screen (Fig.2, note area 54a and/or 54b, within the screen 52, e.g., the area between the header 56a and icons which are just above the silkscreened area 60; column 5, lines 42-44).

Capps does not disclose that the area is a window. However, windows for receiving and displaying handwritten data are well known in the art. For example, Kuriyama teaches a hand-held electronic apparatus (Fig.1), which includes a touch-enabled screen (Fig.1, element 14), which receives and displays handwritten data in a window (Figs.3B and 3C, area P), wherein the window is restricted to a single location of the screen (Figs.3B and 3C).

Kuriyama's arrangement provides more user friendliness for some since the window is in a fixed location, and is more clearly designated, and there would therefore be no ambiguity as to where the handwriting should be written. Therefore, it would have been obvious to modify Capps' invention according to Kuriyama's teaching.

Claim 55, Kuriyama teaches that the window is smaller in size than the touch-enabled screen (Figs.3B and 3C).

Claim 56, Kuriyama teaches that the particular location of the window is a lower portion of the touch-enabled screen (Figs.3B and 3C).

Claim 57, Kuriyama does not disclose that the window occupies less than one third of the touch-enabled screen and spans a width of the touch-enabled screen.

However, this is not considered to patentably distinguish the claim from the prior art. To have the window a particular size is a decision to be made based on designer preference. A designer would utilize a particular window size to accommodate a particular application, or achieve a particular look, for example.

Claim 58, Kuriyama teaches that the window includes at least one action icon (Figs.3B or 3C, elements 31, 32, 33 or 34).

Claim 59, Kuriyama teaches the window always appears at a specific location of the touch-enabled screen when activated (Figs.3B or 3C).

Claim 60, Kuriyama teaches that the window may appear on, and disappear from, the touch enabled screen (note it disappears in the key-input process, Fig.3A, and appears in the handwriting input process, Figs.3B and 3C).


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jon Chang
Primary Examiner
Art Unit 2623

Jon Chang
May 29, 2004